

REMARKS/ARGUMENTS

Claims 3-6 and 8 are now active in this application. The indication that claims 3, 4, 6 and 8 are allowable is acknowledged and appreciated.

REJECTION OF CLAIMS UNDER 35 U.S.C. § 103

Claim 5 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Mallinckrodt (USPN 5,840,753) in view of Bond et al. (USPN 3,836,969).

The rejection is respectfully traversed.

Legal precedent is well developed with respect to 35 U.S.C. § 103. As stated in *Graham v. John Deere Co.* 383 U.S. 1, 13, 148 USPQ 459, 465 (1966), obviousness under 35 U.S.C. § 103 must be determined by considering (1) the scope and content of the prior art; (2) ascertaining the differences between the prior art and the claims in issue; and (3) resolving the level of ordinary skill in the pertinent art. The PTO is thus charged with the initial burden of identifying a source in the applied prior art for: (1) claim features; and (2) the realistic requisite motivation for combining applied references to arrive at the claimed invention with a reasonable expectation of successfully achieving a specific benefit. *Smith Industries Medical Systems v. Vital Signs*, 183 F.3d 1347, 51 USPQ2d 1415 (Fed. Cir. 1999). This burden is not met if there is no showing that the combination of references would actually meet all the limitations of the claims under consideration.

An Office Action rejection must provide a reason why one having ordinary skill in the art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 227 USPQ 657 (Fed. Cir. 1985); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988);

Stratoflex, Inc. v. Aeroquip Corp., 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *In re Warner*, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967).

The Examiner should recognize that even if the prior art *could* be modified so as to result in the combination defined by the claims the modification would not have been obvious unless the prior art suggested the desirability of the modification. *In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986). In the absence of such a prior art suggestion for modification of the references, the basis of the rejection is no more than inappropriate hindsight reconstruction using appellant's claims as a guide. *In re Warner*, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967).

What may or may not be known in general does not establish the requisite realistic motivation to support the ultimate legal conclusion of obviousness under 35 U.S.C. § 103. *In re Deuel*, 51 F.3d 1552, 34 USPQ2d 1210 (Fed. Cir. 1995). The requisite motivation is not an abstract concept, but must stem from the applied prior art as a whole and have realistically impelled one having ordinary skill in the art, at the time the invention was made, to modify a reference in a specific manner to arrive at a specifically claimed invention with a reasonable expectation of achieving a specific benefit. *In re Newell*, 891 F.2d 899, 13 USPQ2d 1248 (Fed. Cir. 1989). It is submitted that the prior art does not meet these criteria for any of the claims under rejection. The question is not what one having ordinary skill in the art could or could not do, but: *why* would one having ordinary skill in the art have been realistically impelled to deviate from the express teachings of the prior art to arrive at the claimed invention? *Gentry Gallery v. Berkline*, 134 F.3d 1473, 45 USPQ2d 1498 (Fed. Cir. 1998); *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992).

It is submitted that the rationale stated in the Office Action for concluding obviousness is not sufficient to meet the above legal criteria. The Office Action recognizes that Mallinckrodt does not teach the following requirement of independent claim 5:

repositioning said second satellite antenna to receive the
return signal from only a second of the plurality of satellites during
periods when the sun transits behind said first satellite; and
receiving the return signal [at one of the first and] second
satellite [at said second satellite antenna during said periods].

However, what Mallinckrodt discloses is simply a control architecture for a conventional communication system which communicates with an *omni directional* satellite antenna mounted on an automobile. Fig. 1(a). Working with such *omni directional* satellite antenna clearly does not require “aligning a [first satellite] antenna to illuminate a plurality of satellites” (claim 5). More specifically, there is no disclosure or suggestion in Mallinckrodt of a positive step of “aligning” the *omni directional* satellite antenna to illuminate, for example, the left and right satellite nodes 20 of FIGS. 1 (a), 1(b) and 3. This is to be expected since such positive aligning is not required by an *omni directional* satellite antenna.

In Mallinckrodt, each of the satellite nodes that receives the transmission from the *omni directional* satellite antenna returns a forward call report and a *signal quality report* to the system network control center 12 which then designates a particular satellite node 20 for handling the call (see column 10, lines 17-29). As interpreted by the Examiner, referring to FIG. 1 (b) of Mallinckrodt, the first satellite antenna is *omni directional* satellite antenna 22 and the return signal is the signal broadcast back to *omni directional* satellite antenna 22 from each narrow beamwidth antenna 62 of each satellite node 20. Given such interpretation, and the

teaching in Bond et al. that one of two satellites 20 and 22 operates during a period that the other satellite has a sun-transit outage, it would seem that the *signal quality report* to the system network control center 12 of Mallinckrodt would identify the particular satellite (node) that has the outage due to sun-transit and the network control center 12, using the signal quality report, would not designate this particular satellite node 20 for handling the call. Furthermore, Mallinckrodt discloses individual satellite antennas of satellite node control 18, 42 in communication with a particular antenna 70 of a particular satellite node 20. The particular antenna 70 of the particular satellite node 20 would be used for forwarding and receiving the call signals to the landlines connected to satellite node control 18, 42. As each of the antenna connected to satellite node control 18, 42 is already positioned on a particular one of the antenna 70 of the two shown satellite nodes 20 of FIGS. 1(a), 1(b), it is unrealistic to presume that there would be a “repositioning” of an antenna shown connected to satellite node control 18, 42 to receive the return signal from the antenna 70 of the other satellite (e.g., right satellite node 20 of FIG. 1(b)) during periods when the sun transits behind the first satellite (e.g., left satellite node 20 of FIG. 1(b)).

Finally, the Office Action lacks specific description of how the Examiner proposes to modify the Mallinckrodt system to “incorporate” the “teaching” of Bond et al. What the Examiner asserts is that “it would have been obvious to the ordinary skill in the art at the time the invention was made to provide the above teaching of Bond to Mallinckrodt, in order for satellite system to avoid sun transit outage”. It is submitted that the Examiner’s assertion is a mere generality that lacks specificity.

The proposed modification, rather than a mere substitution of parts, would encompass a substantial structural and functional reorganization of the Mallinckrodt system, which has yet to

be explained by the Examiner. While the Office Action is silent as to precisely how Mallinckrodt is to be modified, it appears also that such modification would not be necessary, given the manner which Mallinckrodt is intended to function, and may also destroy the operational functionality intended by Mallinckrodt.

In summary, it is submitted that the Office Action has not established that a person of ordinary skill in the art would have been motivated to modify the express teachings of the prior art references to provide an implementation that has not been described in the Office Action in other than general functional terms. Improper hindsight considerations of the present disclosure cannot be a basis for providing specific structure of a purported obvious modification. Consequently, withdrawal of the rejection and allowance of claim 5 are respectfully solicited.

CONCLUSION

Accordingly, it is urged that the application is in condition for allowance, an indication of which is respectfully solicited. If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, Examiner is requested to call Applicants' attorney at the telephone number shown below.

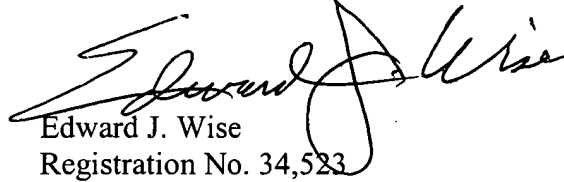
To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper,

Serial No.: 09/216,036

including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY

A handwritten signature in black ink, appearing to read "Edward J. Wise", written over the printed name and registration number.

Edward J. Wise

Registration No. 34,523

Please recognize our Customer No. 20277 as our correspondence address.

600 13th Street, NW
Washington, DC 20005-3096
(202) 756-8000 EJW/jrj
Facsimile: (202) 756-8087
Date: September 1, 2005